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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/199,447	11/25/1998	YASUNOBU FUJITA	XA-8993	3708

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EXAMINER

JOHNSON, JERRY D

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 03/25/2003

27

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/199,447

Applicant(s)

FUJITA ET AL.

Examiner

Jerry D. Johnson

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on January 16, 2003 has been entered.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiraishi et al.

Shiraishi et al., U.S. Patent 5,656,582, teach a rust preventive lubricating oil which prevents bearings from rusting without adversely affecting various characteristics of bearings such as torque, sound and life (column 1, lines 5-9). The rust preventive oil contains a rust-preventive agent and a base oil as essential components. This base oil must contain an ether oil (column 1, lines 57-60). Viscosity of the ether oil per se and ether oil-containing mixtures used as a base oil is usually 10-100 mm²/s @ 40°C (column 3, lines 8-11). The rust preventive lubricating oil can contain an oiliness improver together with the rust-preventive agent and the base oil. The oiliness improver further improves lubricating performances such as wear resistance. The oiliness improvers include, for example, higher alcohols, carboxylic acids such as oleic acid, amines such as stearylamine, organomolybdenum compounds such as molybdenum

Art Unit: 1764

dithiophosphate, phosphate esters such as tricresyl phosphate, phosphor-based and sulfur-based additives and mixtures of them such as a mixture of oleic acid and tricresyl phosphate . (Column 3, lines 15-26). The rust preventive lubricating oils are suitably used for bearings provided with an outer ring having an outer ring raceway track on its inner periphery, an inner ring having an inner raceway track on its outer periphery, a plurality of balls provided between the outer ring track and the inner ring track and a cage which holds the balls so that they can freely roll, especially small bearings such as sealed ball bearings (column 4, lines 7-14).

While Shiraishi et al. differ from the instant claims in not specifically disclosing a lubricating oil containing an extreme pressure agent and a corrosion preventing agent, the oiliness improvers of Shiraishi et al. include the instantly claimed extreme pressure agents and corrosion preventing agents. Accordingly, applicants roller bearing would have been obvious to one having ordinary skill in the art at the time the invention was made as being encompassed by the teachings of Shiraishi et al.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiraishi et al. as applied to claims 1 and 12-14 above, and further in view of Suzuki et al.

Shiraishi et al. is relied on as cited above, but differs from claim 15 in not disclosing molybdenum dithiocarbamate as a suitable oiliness additive.

Suzuki et al., U.S. Patent 5,640,769, is relied on as teaching roller bearing as taught by Shiraishi et al wherein said roller bearing contains a lubricating oil composition comprising an oiliness agent. The oiliness agents include, *inter alia*, organomolybdenum compounds such as molybdenum dithiocarbamate and molybdenum dithiophosphate (column 8, lines 46-56).

Art Unit: 1764

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use molybdenum dithiocarbamate as the oiliness agent in a lubricating oil for a bearing as taught by Shiraishi et al. because Shiraishi et al. teach that organomolybdenum compounds such as molybdenum dithiophosphate may be used as oiliness agents and Suzuki et al. teach the equivalent use of molybdenum dithiophosphates and molybdenum dithiocarbamates in bearing oil compositions.

Claims 2-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiraishi et al. and Suzuki et al. as applied to claims 1 and 12-15 above, and further in view of Noguchi et al. and Dunfield et al.

Shiraishi et al. and Suzuki et al. are relied on as cited above but differ from the instant claims in not disclosing that the inner and outer races are made of steel and the roller bearings are made of ceramics or "super-hard" alloy.

Noguchi et al., U.S. Patent 5,882,122, teach that ball bearings made of ceramic or a hard metal. having a surface hardness of Hv 950-Hv 1,800 (column 9, lines 34-38).

Dunfield et al., U.S. Patent 5,844,748, teach that ball bearings typically having inner and outer races made of steel (column 2, lines 5-6). Ceramic bearing balls are taught in column 8, line 43 to column 9, line 27.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the rust preventive lubricating oil as taught by Shiraishi et al. and Suzuki et al. in a roller bearing wherein said roller bearing has inner and outer races made of steel and bearing balls made of ceramic or "super-hard" alloy as taught by Noguchi et al. and Dunfield et al.

Art Unit: 1764

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification, as originally filed, does not support the now claimed range of “greater than 100 and not exceeding 150 mm²/s.”

Applicant's arguments filed January 16, 2003 have been fully considered but they are not persuasive.

Applicants argue

the fact that Applicants are claiming a particularly preferred range within the broader range supported by the disclosure does not render the claims deficient under § 112, first paragraph. (REMARKS, page 3).

Applicants' argument lacks merit.

The specification, as originally filed, fails to teach or disclose the “particularly preferred range” now claimed.

Applicants argue

Shiraishi does not actually teach any specific composition having both an oiliness improver (which the Office equates with Applicants' claimed extreme pressure agent) and a dynamic viscosity greater than 100 mm²/s at 40° C. Note that the only specific examples containing an oiliness improver in Shiraishi all use base oils having a viscosity in the range of 17-20 mm²/s. (see examples 11-16, and note also comparative examples 3-4). This is nowhere close to the viscosity range set forth in Applicants' Claim 1 and, if anything, would lead one away from the

Art Unit: 1764

use of Shiraishi's oiliness improver in compositions with oil viscosities [sic] in Applicants claimed range. (REMARKS, pages 3 and 4).

Applicants' argument lacks merit.

The disclosure of Shiraishi et al. is not limited to the specific examples. Shiraishi et al. teach that the viscosity of the base oil "is usually 10-100 mm².S⁻¹/40° C. If the viscosity is lower than 10 mm².S⁻¹/40° C., increase in the endurance of bearings cannot be expected. If it is more than 100 mm².S⁻¹/40° C., the action of inhibit generation of cage sound is insufficient" (column 3, lines 8-14; emphasis added). Accordingly, Shiraishi et al. do teach lubricating compositions, howbeit less desirable compositions wherein the viscosity is greater than 100 mm².S⁻¹/40° C. In any event, there is virtually no difference between a viscosity "greater than 100 mm²/s at 40°C" and a viscosity of 100 mm²/s at 40°C as taught by Shiraishi et al.

Applicants argue

Applicants' invention provides a highly effective solution to the problem of fretting corrosion in grease-filled spindle support bearings, a problem that Shiraishi does not even address (REMARKS, page 4).

Applicants' argument lacks merit.

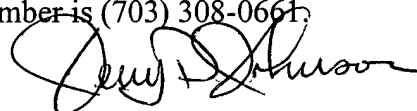
In response to applicant's argument that Shiraishi et al does not address applicants' problem, the fact that applicants have recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (703) 308-2515. The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

Art Unit: 1764

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Caldarola can be reached on (703) 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read "Jerry D. Johnson", is written over the printed name and title.

Jerry D. Johnson
Primary Examiner
Art Unit 1764

JDJ
March 21, 2003